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PTO/SB/05 (03-01)

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**UTILITY  
PATENT APPLICATION  
TRANSMITTAL**

(Only for new nonprovisional applications under 37 C.F.R. 1.53(b))

Attorney Docket No. 2183-4285.1US

First Inventor Goulmy et al.

Title THE HA-1 ANTIGEN

Express Mail Label No. EV326919743US

**APPLICATION ELEMENTS**

See MPEP chapter 600 concerning utility patent application contents.

1. ☐ Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original and a duplicate for fee processing)
2. ☐ Applicant claims small entity status.  
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 36 ]  
(preferred arrangement set forth below)  
- Descriptive title of the Invention  
- Cross Reference to Related Applications  
- Statement Regarding Fed sponsored R & D  
- Reference to sequence listing, a table,  
or a computer program listing appendix  
- Background of the Invention  
- Brief Summary of the Invention  
- Brief Description of the Drawings (if filed)  
- Detailed Description  
- Claim(s)  
- Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 12 ]
5. Oath or Declaration [Total Pages 3 ]  
a. ☐ Newly executed (original or copy)  
b. ☒ Copy from a prior application (37 CFR 1.63 (d))  
(for a continuation/divisional with Box 18 completed)  
i. ☐ **DELETION OF INVENTOR(S)**  
Signed statement attached deleting inventor(s)  
named in the prior application, see 37 CFR  
1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76

**ADDRESS TO:**Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

7. ☐ CD-ROM or CD-R in duplicate, large table or  
Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission  
(if applicable, all necessary)  
a. ☐ Computer Readable Form (CRF)  
b. Specification Sequence Listing on:  
i. ☐ CD-ROM or CD-R (2 copies); or  
ii. ☐ paper  
c. ☐ Statements verifying identity of above copies

**ACCOMPANYING APPLICATIONS PARTS**

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 C.F.R. §3.73(b) Statement [ ] Power of Attorney  
(when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☒ Information Disclosure [ ] Copies of IDS  
Statement (IDS)/PTO-1449 Citations
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)  
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)  
(if foreign priority is claimed)
16. ☐ Nonpublication Request under 35 U.S.C. 122  
(b)(2)(B)(i). Applicant must attach form PTO/SB/35  
or its equivalent.
17. ☒ Other: Request to Transfer CRF; Petition for  
Retroactive Foreign Filing License

18. If a **CONTINUING APPLICATION**, check appropriate box, and supply the requisite information below and in a preliminary amendment,  
or in an Application Data Sheet under 37 CFR 1.76:

☒ Continuation ☐ Divisional ☐ Continuation-in-part (CIP)

of prior application No: 09 / 489,760

Prior application information: Examiner P. Huynh

Group / Art Unit: 1644

For **CONTINUATION** or **DIVISIONAL APPS** only: The entire disclosure of the prior application, from which an oath or declaration is supplied  
under Box 5b, is considered a part of the disclosure of the accompanying or divisional application and is hereby incorporated by reference.  
The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

**19. CORRESPONDENCE ADDRESS**☒ Customer Number

24247

or ☐ Correspondence address below

Name

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Name (Print/Type)

Allen C. Turner

Registration No. (Attorney/Agent)

33,041

Signature

Allen C. Turner Reg. No. 47,825 For Allen C. Turner

Date

March 2, 2004

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any  
comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark  
Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Patent Application,  
Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re Application of:**

Goulmy et al.

**Serial No.:** To be assigned

**Filed:** March 2, 2004

**For:** THE HA-1 ANTIGEN

**Examiner (presumed):** P. Huynh

**Group Art Unit (presumed):** 1644

**Attorney Docket No.:** 2183-4285.1US

NOTICE OF EXPRESS MAILING

Express Mail Mailing Label Number: EV326919743US

Date of Deposit with USPS: March 2, 2004

Person making Deposit: Christopher Houghton

**PETITION FOR A RETROACTIVE LICENSE  
UNDER 35 U.S.C. § 184**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The applicants hereby petition for a retroactive license under 35 U.S.C. § 184 in accordance with 37 C.F.R. § 5.14(a) for the above-referenced US application.

The applicants request retroactive foreign filing licenses for the following applications:

Foreign Country	Filing Date	Application Number (Patent Number)
European Patent Office	July 23, 1997	EP 97202303.0
Netherlands	July 23, 1998	PCT/NL98/00424
Japan	July 23, 1998	JP19982000504165 (JP2001510851T2)
European: Austria, Belgium, Switzerland, Germany, Denmark, Spain, France, United Kingdom, Greece, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Portugal, and Sweden	July 23, 1998	EP1998000936758 (EP0996636)
Australia	July 23, 1998	AU1998199885640 (AU8564098A1)
Australia	July 23, 1998	AU1998199885639 (AU8563998A1)
Australia	July 23, 1998	AU1998000085639 (AU0756962B2)

The first filing is the priority document, EP 97202303.0, filed July 23, 1997, now abandoned. Within one year of the priority document, an international PCT application was filed, PCT/NL98/00424, on July 23, 1998, designating all of the member states and regional offices. The Japanese, European and Australian patents referenced herein represent national entries of the PCT application.

A declaration by Dr. Victor H. Engelhard is attached herewith, avering to diligence in obtaining the retroactive foreign filing license. A declaration by Dr. Donald F. Hunt is also attached.

Pursuant to 37 C.F.R. § 5.25(a)(3)(ii) and (iii), the foreign filing of the priority document and the international PCT application, as well as the national entries effected from the international filing, were prepared and filed by the Assignee, Rijksuniversiteit te Leiden, a University in the Netherlands, through European counsel, who were unfamiliar with US Patent Law and the requirement of a foreign filing license. Therefore, until the international application entered the United States Patent and Trademark Office (USPTO), there was no knowledge of the pertinent law and facts (Patent Office Rules and Practice Rule 1.14, section VII) (copy attached). Thus, the possible need for a foreign filing license did not become apparent to the Applicants until at least the entry of the application into the USPTO (*In re Application* filed November 22, 1952, 837 O.G. 1046, 153 U.S.P.Q. 410 (Comm'r Pat. and Trademarks 1967)), which explains why the material was filed abroad (in the Assignee's and an inventor's home country) through error and without deceptive intent, without the required license (37 C.F.R. § 5.25 (a)(3)(iii)).

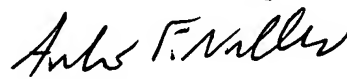
It is submitted that diligence in obtaining a retroactive foreign filing license is shown by filing the present Petition for a Retroactive License concurrently with the above-referenced continuation application. Furthermore, negotiations involving issues surrounding ownership of the invention were ongoing since filing of the parent application, *i.e.*, US Ser. No. 09/489,760. The ownership issue evidently precluded or hindered the ability to determine if a foreign filing license was, in fact, required and the proper parties who should apply for such a license. In particular, if the parties from the US were not co-inventors, then no foreign filing license would be necessary.

As indicated in the attached declaration, the potential need for a retroactive foreign filing license and a declaration was inadvertently not communicated to the inventors. Upon learning of the possible need for a foreign filing license, the inventor, Dr. Victor H. Engelhard, diligently executed the attached declaration.

Pursuant to 37 C.F.R. § 5.25(a)(3)(ii), the present petition for a retroactive filing license is being filed concurrently with the above-referenced continuation application. Thus, the

resolution of the foreign filing license is being sought concurrently with the filing of the above-referenced continuation application and before the grant of a U.S. Patent resulting from the above-referenced continuation application "in order that the status of the patent may be known with certainty" (Patent Office Rules and Practice Rule 14, section V, citing *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*, 143 USPQ 278 (7th Cir. 1964)). Applicants submit that under the circumstances of the present case, for example, resolution of ownership and inventorship, as well as, prosecution by the assignee, the Rijksuniversiteit te Leiden, through European associates, diligence has been pursued in obtaining a retroactive foreign filing license.

Respectfully submitted,



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Date: March 2, 2004  
AFN

Enclosures: Declaration of Donald F. Hunt  
Declaration of Victor H. Engelhard  
Rule 14